



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,347	06/25/2003	Andrew Egendorf	7178-223	2599
7590	09/06/2005		EXAMINER FELTEN, DANIEL S	
Clifford Chance US LLP 200 Park Avenue New York, NY 10166-0153			ART UNIT 3624	PAPER NUMBER

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,347

Applicant(s)

EGENDORF, ANDREW

Examiner

Daniel S. Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/23/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18, 21-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al (US 4,799,156) in view of Chen et al (US 5,590,197).

-Shavit discloses establishing a billing agreement with at least one a remitting agreement with at least one vendor to bill a billing account of the at least one customer for products and services purchased over the network by the at least one customer from the at least one vendor and to remit to the at least one vendor, (see Shavit, col. 5, lines 39-65; see "umbrella agreement", col. 12, line 54 to col. 13, line 9; col. 13, lines 35-50; and col. 26, lines 5-49), as in claims 1, 23,

-connecting the at least one customer to the network, (see Shavit, col. 14, lines 50-62), as in claim 1 and 21

-obtaining transactional information over the network from communications over the network between the at least one customer and the at least one vendor related to a

Art Unit: 3624

purchase over the network from the at least one vendor, information includes a transaction amount, (col. 14, lines 10-49) *as in claim 1*; and

--Obtaining approval from a party other than the customer to bill the transaction amount to the billing account of the at least one customer, (see Shavit, col. 8, ll. 55 to col. 9, line 6), *as in claim 2*,

---wherein approval is obtained from the provider, (see Shavit, col. 8, ll. 55 to col. 9, line 6), *as in claim 3*,

---wherein the approval is obtained by the third party, (see Shavit, col. 8, ll. 55 to col. 9, line 6), *as in claim 4*,

---wherein the approval is obtained from a third party, (see Shavit, col. 8, ll. 55 to col. 9, line 6), *as in claim 5*,

---- the approval is obtained during communications between the at least one customer and the at least one vendor, (see Shavit, col. 8, ll. 55 to col. 9, line 6), *as in claim 6*,

--wherein the billing account is one of a credit card account, a banking account, a cable television account, and an online services account, (see col. 28, lines 24-56), *as in claim 7*,

--the step of establishing the billing agreement comprises establishing a specification for selecting a billing account to which the transaction amount is billed, (see col. 28, lines 24-56), *as in claim 8*,

Art Unit: 3624

--wherein the step of establishing the billing agreement comprises specifying a plurality of billing accounts and wherein the transactional information includes identification of one of the plurality of billing without specifying an account number, (see col. 28, lines 24-56),
as in claim 9, 26

--wherein the billing account is an account with the provider, (see Shavit, col. 8, ll. 55 to col. 9, line 6), *as in claims 10, 17 and 27*

--wherein the billing account is an account with a third party, (see Shavit, col. 8, ll. 55 to col. 9, line 6), *as in claims 11, 18 and 28*

billing the transaction amount to the billing account of the at least one customer,
(see Shavit, col. 12, line 54 to col. 13, line 9; col. 13, lines 35-50), *as in claim 1, and*

remitting a portion of the transaction amount to the at least one vendor,
as in claim 1,

--the step of remitting comprises sending money, (see Shavit, col. 26, ll. 50+), *as in claims 12,*

--wherein the step of remitting comprises creating a vendor account, (see Shavit, col. 8, ll. 55 to col. 6, ll. 6), *as in claim 13,*

Art Unit: 3624

---where the vendor account is one of a credit card merchant account, a bank account, a telephone number account, a cable television account, and an on-line services account, (see Shavit, col. 12, ll. 54 to col. 13, line 9), *as in claim 14*,

---the step of establishing the remitting agreement comprises establishing the remitting agreement comprises establishing a specification for selecting a vendor account to which a portion of the transaction amount is remitted, (see Shavit, col. 12, ll. 54 to col. 13, line 9), *as in claim 15*,

---the step of establishing the remitting agreement comprises specifying a plurality of vendor accounts and wherein the transactional information includes identification of one of the plurality of vendor accounts to which the transaction amount is billed without specifying an account number, (see Shavit, col. 12, ll. 54 to col. 13, line 9), *as in claims 16*,

-establishing a remitting agreement with at least one Internet access provider to remit to the vendor a portion of the transaction amount billed to the billing account of at least one customer of the at least Internet access provider for products and services purchased over the Internet by the at least one customer from the vendor (see Shavit, col. 12, lines 54+; col. 13, lines 35+), *as in claim 1*,

-Exchanging transactional information over the network with at least one customer related to a purchase over the Internet by the at least one customer from the vendor,

Art Unit: 3624

wherein the transactional information includes a transaction amount, (see Shavit, col. 14, lines 10-49), *as in claim 21,*

-delivering the purchased product or service to the at least one customer, *as in claim 21,* and

-receiving the portion of the transaction amount from the at least one internet access provider, *as in claim 21,*

--wherein the step of receiving comprises receiving money, *as in claim 22,* (see Shavit, col. 8, lines 23-37)

--the step of receiving comprises receiving a credit to a vendor account, *as in claim 23,* (see Shavit, col. 8, lines 37-54)

---wherein the vendor account is one of a credit card merchant account, a bank account, a telephone number account, a cable television account, and an on-line services account, *as in claim 24,* (see Shavit, col. 5, line 51-65)

---wherein the step of establishing the remitting agreement comprises, *as in claim 25,* (see Shavit, col. 13, lines. 35-50)

Shavits fails to disclose, as in claim 1, connecting the customer to the Internet. Chen teaches the viability of the Internet as a network to make customer purchases and payments to a merchant particularly in the protection of account information and compatibility with existing electronic payment infrastructures (see Chen col. 3, line 11 to col. 4, line 31). Since Shavit uses a network to make transactions between customers and vendors, it would have been obvious for an artisan at the time of the invention to provide the latest networking technology (e.g., the Internet) to allow the widest customer use and to increase the amount of choice available to the customer and/or vendor by being able to participate in a global (rather than a local) marketplace of goods and services. Thus such a modification would have constituted an obvious expedient to one of ordinary skill in the art.

3. Claims 19, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit as modified by Chen in further view of Rosen (US 5,557,518) .

Shavit as modified by Chen fails to disclose wherein the transactional information does not include the billing account number to which the transaction amount is billed, *as in claim 19, 20 and 30*. Rosen teaches a system for enabling the secure delivery of electronic merchandise with real-time **anonymous** payment transaction (see Rosen, col. 3, lines 3-66 to col. 4, line 37). In view of Shavit as modified by Chen, one of ordinary skill in the art would have recognized the notoriously old and well known problems concerning the security of electronic transactions

Art Unit: 3624

(e.g., money, personal information, etc.,) and have sought to employ the techniques of Rosen to create a secure transaction environment for both the buyer and the vendor (seller) of the electronic merchandise and services. Thus such a modification would be considered an obvious expedient to one of ordinary skill in the art.

Art Unit: 3624

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (703) 305-0724.

The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel S Felten
Examiner
Art Unit 3624



DSF
August 26, 2005



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600